REMARKS

Claim Rejections

Claim 1-3 and 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Chen (6,610,598). Claims 8-10 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen. Claims 4, 6, 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Chen et al. (2004/0203189). Claims 7 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Lea (5,543,830). Claims 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chen in view of Stokes et al. (6,791,259).

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

Claim Amendments

By this Amendment, Applicant has canceled claims 15-17 and has amended claims 1 and 8 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Chen teaches surface-mounted devices of light-emitting diodes with small lens including a substrate (1), an LED chip (3), an electric conducting electrode (2) located between the substrate and the LED chip, a package material (5), and small lens (6A).

Chen does not teach a light emitting diode chip in direct contact with the substrate; nor does Chen teach a plurality of light emitting diode chips in direct contact with the substrate.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that

Chen does not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Chen cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

Chen et al. teaches an LED power package and is cited for teaching a Fresnel lens.

Chen et al. do not teach a light emitting diode chip in direct contact with the substrate; nor do Chen et al. teach a plurality of light emitting diode chips in direct contact with the substrate.

The secondary reference to Lea teaches an apparatus with light emitting element and is cited for teaching a lens structure with a gradient-refractive index.

Lea does not teach a light emitting diode chip in direct contact with the substrate; nor does Lea teach a plurality of light emitting diode chips in direct contact with the substrate.

The secondary reference to Stokes et al. teaches a solid state illumination system and is cited for teaching an encapsulating layer (156) having light or UV radiation scattering particles.

Stokes et al. does not teach a light emitting diode chip in direct contact with the substrate; nor does Stokes et al. teach a plurality of light emitting diode chips in direct contact with the substrate.

Even if the teachings of Chen, Chen et al., Lea, and Stokes et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a light emitting diode chip in direct contact with the substrate; nor does the combination suggest a plurality of light emitting diode chips in direct contact with the substrate.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over

40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

> As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

> We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Chen, Chen et al., Lea, or Stokes et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Chen, Chen et al., Lea, nor Stokes et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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